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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,894	03/22/2006	Urs Burckhardt	123234	7753
27049	7590	02/03/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER LEONARD, MICHAEL L.	
			ART UNIT 1763	PAPER NUMBER
			NOTIFICATION DATE 02/03/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/529,894

**Applicant(s)**

BURCKHARDT ET AL.

**Examiner**

MICHAEL LEONARD

**Art Unit**

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-10 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-040)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Note***

This rejection contains the same prior art as previous rejections and no new prior art was applied, therefore this rejection can be made FINAL.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

#### **Obviousness Rejection I**

Claims 1, 4-10, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,788,083 to Dammann et al. in view of U.S. Patent No. 3,635,906 to Jayawant. and U.S. Patent No. 4,322,327 to Yoshimura et al. for the reasons set forth in the last Office action.

#### **Obviousness Rejection II**

Claims 1, 4-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,719,229 to Pantone et al. for the reasons set forth in the last Office action.

### **Obviousness Rejection III**

Claims 1, 4-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,322,327 to Yoshimura in view of U.S. Patent No. 5,719,229 to Pantone et al. for the reasons set forth in the last Office action.

### ***Response to Arguments***

Applicant's arguments, see Arguments, filed 01/03/2011, with respect to claims 1, 4-10, and 21 have been fully considered and are persuasive. The rejection of claims 1, 4-10, and 21 under 35 U.S.C. 112, first paragraph and claims 1, 4-10 and 21 under 35 U.S.C. 112, second paragraph has been withdrawn.

Applicant's arguments filed 01/03/2011 have been fully considered but they are not persuasive.

The applicants' argued with respect to Obviousness Rejection I that because the catalyst system is limited to the recited bismuth compound and the aromatic nitrogen compound, the catalyst system of Dammann is different. The examiner respectfully disagrees because the claims are open to other catalysts system as long as one bismuth compound and the aromatic nitrogen compound are present because of the language, "at least one catalyst system". As a result, other catalyst can be present based on the claim language as long as one bismuth compound and the aromatic nitrogen compound are present. Furthermore, the Jayawant and Yoshimura references can still be applied to the claims as written because of the reasons stated above.

The applicants' argued with respect to Obviousness Rejection II that because the catalyst system is limited to the recited bismuth compound and the aromatic nitrogen compound, the catalyst system of Pantone is different. However, the claims are open to other catalysts system as long as one bismuth compound and the aromatic nitrogen compound are present because of the language, "at least one catalyst system".

Pantone discloses:

- a) an isocyanate prepolymer having an isocyanate content of 3 to 15% by weight, prepared from polyisocyanates and polyester polyols
- b) diol chain extenders
- c) catalyst
- d) surface skinning retardants (Abstract).

Furthermore, the examples even though they do not disclose the preferred catalyst system of the claims, disclose only the use of one type of catalyst and one type of surface skinning retardant and a person of ordinary skill in the art could easily select from the list disclosed by Pantone, a bismuth catalyst in combination with isoquinoline and still maintain the desired properties of the polyurethane prepolymer of Pantone because the catalysts and the surface skinning retardants are art recognized equivalents because they are listed as suitable alternatives in an analogous polyurethane reactions. The catalyst system does not require the addition of a tertiary amine; this is one of alternatives to the preferred catalyst of the examples.

The applicants' argued with respect to Obviousness Rejection III that because the catalyst system is limited to the recited bismuth compound and the aromatic nitrogen compound, the catalyst system of Pantone is different. However, the claims are open to other catalysts system as long as one bismuth compound and the aromatic nitrogen compound are present because of the language, "at least one catalyst system". Pantone discloses:

- a) an isocyanate prepolymer having an isocyanate content of 3 to 15% by weight, prepared from polyisocyanates and polyester polyols
- b) diol chain extenders
- c) catalyst
- d) surface skinning retardants (Abstract).

Furthermore, the examples even though they do not disclose the preferred catalyst system of the claims, disclose only the use of one type of catalyst and one type of surface skinning retardant and a person of ordinary skill in the art could easily select from the list disclosed by Pantone, a bismuth catalyst in combination with isoquinoline and still maintain the desired properties of the polyurethane prepolymer of Pantone because the catalysts and the surface skinning retardants are art recognized equivalents because they are listed as suitable alternatives in an analogous polyurethane reactions. The catalyst system does not require the addition of a tertiary amine; this is one of alternatives to the preferred catalyst of the examples.

### **Unexpected Results**

Table 1 (as presented by applicants) in remarks 05/11/2010 did not seem to show an unexpected advantage of viscosity increases when comparing quinoline vs. isoquinoline. 8-hydroxyquinoline, from the prior art is a known NCO-blocking agent and it would not have been unexpected that the adhesive/coating when ejected from the "pack" or "container" when using the isoquinoline would react slower with moisture (lower % increase in viscosity) because some of the NCO-groups had been blocked and thus would not have reacted as quickly with the moisture during cure and would have resulted in a more slowly cured final polyurethane adhesive or coating. Therefore, the advantage of slower viscosity buildup would not be unexpected when considering that the NCO-groups would be blocked from moisture, unable to cure, and thus would maintain its liquid or stored state.

Furthermore, the applicants stated that Jayawant discloses that 8-hydroxyquinoline was added to delay the reaction between the organic polyisocyanate and an organic polyhydroxy compound, thereby extending the pot-life. A person of ordinary skill in the art would see that the delay is caused by the blocking of some NCO-groups by the 8-hydroxyquinoline component and as a result increases the time-lapse catalysis effect.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LEONARD whose telephone number is (571)270-7450. The examiner can normally be reached on Mon-Fri 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/  
Supervisory Patent Examiner, Art Unit 1763

/MICHAEL LEONARD/  
Examiner, Art Unit 1763